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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/777,631	02/06/2001	Douglas W. Kohrs	6683.26USC1	4464

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EXAMINER	
SNOW, BRUCE EDWARD	
ART UNIT	PAPER NUMBER
3738	

DATE MAILED: 07/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/777,631

**Applicant(s)**KOHRS, DOUGLAS W. *CH***Examiner**

Bruce E Snow

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,36-47,49,50 and 53-76 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 36-47, 49, 50, 53-76 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments filed 4/19/04 have been fully considered.

The rejection of claims 63-73 under 35 USC 112, second paragraph, has been withdrawn. Applicant has identified the "traverse member" to be the same thing as the "transverse member". In the previous Office action, the limitation was ambiguous and the Examiner believed applicant was describing elements 31a and 31b as the "traverse members".

A second terminal disclaimer has been received but has not been yet considered by the Office. Upon consideration and approval, the double patenting rejection will be withdrawn.

The Examiner's position regarding the rejection in view of Kohrs (5,609,636) is believed to be adequately described in the grounds of rejection below.

Regarding the rejection in view of Knothe, it is the Examiner's position that the central support member provides rigid support of the first and second load bearing surfaces. It is noted that the bearing surfaces can be compressed elastically to reduce the height for easier insertion between the vertebrae when the central support is in the implantation position, but when the device is implanted in its final configuration as shown in figure 2, the support member fulfills the claim language.

Applicant's arguments regarding the rejection in view of Hochshuler et al (6,045,579) are not persuasive. When the strut 30 is interpreted as the entire implant it is clearly "configured as in implant for intervertebral fusion between opposing vertebrae".

The Examiner notes applicant's use the open transitional language "comprising". Note that the strut shown in figure 6A is not hinged. The struts are fully capable of being implanted without elements 12 and 14 to fulfill the functional language of new claims 73-76. Also, these new claim do not overcome the rejection when the struts are used with elements 12 and 14.

### ***Conclusion***

Applicant's amendment which clarified the scope of the claims using the new claim terminology "traverse"; amendments including claim 61, and the addition of new claims 73-76 necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

### ***Allowable Subject Matter***

Claims 1, 36-47, 49-50, 53-60 would be allowed upon the submission of a proper terminal disclaimer. Applicant indicated a terminal disclaimer would be submitted upon the indication of allowable subject matter.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

All claims are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over all claims of U.S. Patent No. 6224631.

Although the conflicting claims are not identical, they are not patentably distinct from each other claiming the same implant comprising the same elements.

### ***Specification***

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Claims 63-72 use claim language such as "traverse

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member" which is not supported in the specification. It is applicant's duty to assure that all claim language is supported in the specification.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 63-72 and 74-76 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Kohrs (5,609,636).

Referring to all figures, specifically figures 17-19, Kohrs teaches an implant comprising first and second bearing surfaces connected by a plurality of columns 405, 406, 407, 411, 412, 413 arranged two rows "along" or in alignment with the a midline of said bearing surfaces. See definition of "along" below. A row of columns can also be defined as a "central support" located central of the bearing surfaces in a vertical

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direction. Said bearing surfaces having an opposing inner surfaces at least between the two rows of columns; channels are formed on either side of the central support member. The rows bisect the bearing surfaces which giving the broadest reasonable meaning is to divide into two parts but does not have to be two equal parts.

**bi·sect** (biˈsɛktˈ, bi-sɛktˈ) *verb*

**bi·sect·ed, bi·sect·ing, bi·sects** *verb, transitive*

To cut or divide into two parts, especially two equal parts.<sup>1</sup>

**a·long** (e-lɔŋɡˈ, e-lɔŋɡˈ) *preposition*

1. Over the length of: *walked along the path.*
2. On a line or course parallel and close to; continuously beside: *rowed along the shore; the trees along the avenue.*
3. In accordance with: *The committee split along party lines over the issue.*<sup>2</sup>

Claims 61-76 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Knothe (WO 97/15247).

Knothe teaches an implant comprising first and second bearing surfaces 3, 4 connected by a central support; wherein opposing inner surfaces of the first and second load bearing surface form channels on either side of the central support. The central support member provides rigid support of the first and second load bearing surfaces.

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Claims 61-76 are rejected under 35 U.S.C. 102(e) as being **clearly anticipated** by Hochshuler et al (6,045,579). See all figures, specifically figures 6A and 6B wherein element 30 is the entire implant. The reference can also be interpreted wherein element 30 is the central support member between elements 12 and 14.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruce E Snow whose telephone number is (703) 308-3255. The examiner can normally be reached on Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (703)308-2111. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

bes  
June 30, 2004

A handwritten signature in black ink, consisting of a series of loops and a long horizontal stroke extending to the right.

BRUCE SNOW  
PRIMARY EXAMINER